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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,565	02/11/2000	Timothy S. Farlow	12579-002001	5344
26161	7590	05/20/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			BOOKER, KELVIN E	
			ART UNIT	PAPER NUMBER
			2121	8

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,565

Applicant(s)

FARLOW, TIMOTHY S.

Examiner

Kelvin E Booker

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-72 and 81-85 is/are allowed.
- 6) ☒ Claim(s) 73-80 is/are rejected.
- 7) ☒ Claim(s) 79 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Office Action.

DETAILED ACTION

Claim Objections

1. **Claim 79** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. As disclosed, the claim is directed towards a *knowledge-based system*, but is dependent upon a *method for providing information*. Due to this dual representation, it is difficult to determine if the claim is intended to further define the aforementioned *method* as claimed in independent claims 73 and 81, or further define the above-mentioned *system* as disclosed in independent claims 1 and 42.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 73-80** are rejected under the judicially created doctrine of double patenting over **claims 25-30** of U. S. Patent No. 6,633,859 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A method of providing information whereby accessing a presentation template that references at least one knowledge block, using a compiler to incorporate information into the presentation template, and displaying the presentation to a user.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2121

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 73-80** are rejected under 35 U.S.C. 102(e) as being anticipated by Farlow et al., U.S. Patent No. 6,633,859 [hereafter Farlow].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As per claim 73, Farlow et al teaches of a method of providing information, the method comprising the steps of:

A. accessing a presentation template that references at least one knowledge block (see column 10, lines 50-56);

B. incorporating information into the presentation template by means of a compiler based on the contents of the at least one knowledge block referenced by the presentation template (see column 10, lines 60-63); and

C. displaying a presentation to a user comprising the presentation template and the incorporated information in a format designed to facilitate comparative analysis (see figure 7; column 8, lines 40-53; and column 10, lines 65-67).

As per claim 74, Farlow et al teaches of a method wherein the format is a comparison table (see figure 7; and column 8, lines 40-53).

As per claim 75, Farlow et al teaches of a method wherein the presentation template is accessed in response to a user query (see column 11, lines 4-6).

As per claim 76, Farlow et al teaches of a method wherein the information is derived based on the interpretation by the compiler of the at least one knowledge block (see column 11, lines 1-3 and 7-10).

As per claim 77, Farlow et al teaches of a method wherein the compiler interprets in view of the context in which a user is operating rules, text, and at least one variable contained in said at least one knowledge block (see column 11, lines 7-10).

As per claim 78, Farlow et al teaches of a method wherein the presentation contains human resource-related information and the value associated with the at least one variable is determined by the compiler after the user context is determined (see column 11, lines 11-16).

As per claim 79, Farlow et al teaches of a knowledge-based system wherein the context in which a user is operating is determined by factors selected from the group consisting of user-defined employee instantiations, employee group instantiations, employer instantiations, plan instantiations and effective date (see column 11, lines 11-16).

As per claim 80, Farlow et al teaches of a method further comprising hierarchically organizing the content in the at least one knowledge block within the knowledge model (see column 11, lines 17-19).

Allowable Subject Matter

6. Claims 1-72 and 81-85 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

the cited prior art fails to explicitly teach of a knowledge-based comparative information dissemination system consistent with the limitations of independent **claims 1, 42, and 81**, wherein a compiler is employed in accessing and making available to a user, multiple instantiations of a knowledge model based upon queries from a system user with a defined context.

Conclusion

8. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- A. Omoigui, U.S. Patent Application Publication No. 2003/0126136;
- B. Vitale et al., U.S. Patent No. 6,347,295;
- C. Farlow et al., U.S. Patent Application Publication No. 2003/0225720;
- D. Loofbourrow et al., U. S. Patent No. 6,640,216;
- E. Loofbourrow et al., U.S. Patent No. 6,505,183;

F. Vanbuskirk et al., U.S. Patent No. 6,523,004;

G. Roberge et al., U.S. Patent Application Publication No. 2002/0072896;

H. Jiang et al., U.S. Patent Application Publication No. 2004/0044952;

I. Sundermier, U.S. Patent No. 6,484,214;

J. Bauman et al., U.S. Patent No. 5,398,304;

K. Bauman et al., U.S. Patent No. 5,402,526;

L. Harhen, U.S. Patent No. 5,406,477;

M. Exertier, U.S. Patent No. 5,832,498;

N. Archer et al., U.S. Patent No. 6,473,748;

O. Simoudis et al., U.S. Patent No. 5,692,107; and

P. Farlow et al., U.S. Patent No. 6,633,859.

9. An inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Booker whose telephone number is (703) 308-4088. The examiner can normally be reached on Monday-Friday from 7:00 AM-5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (703) 308-3179. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Anthony Knight
Supervisory Patent Examiner
Group 3600

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K.E.B.

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May 4, 2004